

ESTTA Tracking number: **ESTTA847760**

Filing date: **09/22/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Petition for Cancellation**

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

**Petitioner Information**

Name	Software Freedom Law Center		
Entity	Corporation	Citizenship	New York
Address	1995 Broadway, 17th Floor New York, NY 10023 UNITED STATES		

Attorney information	Daniel Byrnes Software Freedom Law Center 1995 Broadway, 17th Floor New York, NY 10023 UNITED STATES Email: dbyrnes@softwarefreedom.org		
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**Registration Subject to Cancellation**

Registration No.	4212971	Registration date	09/25/2012
Registrant	Software Freedom Conservancy 137 Montague Street Suite 380 Brooklyn, NY 11201 UNITED STATES		

**Goods/Services Subject to Cancellation**

<p>Class 009. First Use: 2005/09/17 First Use In Commerce: 2005/09/17 All goods and services in the class are subject to cancellation, namely: Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Brailledisplays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operatingsystem tools for use in embedded systems, provided freely and openly licensed use for the public good</p>
<p>Class 035. First Use: 2005/09/17 First Use In Commerce: 2005/09/17 All goods and services in the class are subject to cancellation, namely: Charitable services,Â namely, promoting public awareness of free, libre and opensource software projects, and developing and defending the same</p>

**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Registration	3913979	Application Date	06/17/2010
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No.			
Registration Date	02/01/2011	Foreign Priority Date	NONE
Word Mark	SOFTWARE FREEDOM LAW CENTER		
Design Mark	<p style="text-align: center;"><b>Software Freedom Law Center</b></p>		
Description of Mark	NONE		
Goods/Services	Class 045. First use: First Use: 2005/02/09 First Use In Commerce: 2005/02/09 Legal services		

Attachments	85065598#TMSN.png( bytes ) sflc-v-sfc-petition-for-cancellation.pdf(72053 bytes )
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Signature	/Daniel Byrnes/
Name	Daniel Byrnes
Date	09/22/2017

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 4,212,971

For the mark: SOFTWARE FREEDOM CONSERVANCY

Registered: September 25, 2012

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Software Freedom Law Center, Inc.,

Petitioner,

v.

Software Freedom Conservancy, Inc.,

Registrant.

Cancellation No. \_\_\_\_\_

----- X

**PETITION FOR CANCELLATION**

Software Freedom Law Center (“Petitioner”), a 501(c)(3) tax exempt not-for-profit corporation having its principal place of business at 1995 Broadway, 17<sup>th</sup> Floor, New York, NY 10023, believes that it has been and will continue to be damaged by U.S. Trademark Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, and hereby petitions to cancel the same pursuant to Section 14 of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064.

As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is a not-for-profit law firm that provides pro-bono legal services to protect and advance free and open source software (FOSS).
2. Petitioner is the owner of valid and subsisting United States Trademark Registration No. 3,913,979 on the Principal Register in the United States Patent and Trademark Office (“USPTO”) for

the service mark SOFTWARE FREEDOM LAW CENTER (hereinafter “SOFTWARE FREEDOM LAW CENTER Mark”) for LEGAL SERVICES, which issued on February 1, 2011, and has become incontestable within the meaning of Section 15 of the Lanham Act, 15 U.S.C. § 1065. Attached as Exhibit 1 is a true and correct printout from the USPTO electronic database showing the current status and title of the registration as of September 22, 2017.

3. Petitioner has used the SOFTWARE FREEDOM LAW CENTER Mark in interstate commerce in the United States continuously since February 9, 2005 in connection with the provision of legal services.

4. As a result of widespread, continuous, and exclusive use of the SOFTWARE FREEDOM LAW CENTER Mark to identify its legal services and the Petitioner as their source, Petitioner owns valid and subsisting federal statutory and common law rights to the SOFTWARE FREEDOM LAW CENTER Mark.

5. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is distinctive to both the consuming public and Petitioner's trade.

6. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is symbolic of extensive goodwill established by Petitioner, and has acquired a high degree of recognition through continued use and expenditures of time, effort, and money, and serves as a unique identifier of the services offered by Petitioner.

7. Upon information and belief, Registrant, Software Freedom Conservancy, with an address at 137 Montague Street Suite 380, Brooklyn, New York 11201, and an email address at [tony@softwareconservancy.org](mailto:tony@softwareconservancy.org), is the current listed owner of Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, in connection with “Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating

systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed use for the public good” in International Class 9, and “Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same” in International Class 35. That trademark registration, based on an application filed on November 29, 2011, was issued on September 25, 2012 and bears a first-use date of September 17, 2005.

8. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark has priority over Registrant's mark because Petitioner's first-use and registration dates for the SOFTWARE FREEDOM LAW CENTER Mark predate the filing date of Registrant's application for Registration No. 4,212,971 or any other date on which the Registrant may rely for purposes of priority.

9. Karen M. Sandler, an attorney employed by Petitioner from on or about October 31, 2005 through on or about June 21, 2011, filed the application for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO on Petitioner's behalf on June 17, 2010.

10. Registrant was established on April 3, 2006 by employees of Petitioner, including Bradley M. Kuhn, as a legal entity separate from Petitioner in order to provide free financial and administrative services to FOSS projects and developers.

11. At its inception, the organizations of Petitioner and Registrant had one board member in common, and employees of Petitioner, including Karen M. Sandler and Bradley M. Kuhn, served as Officers of Registrant on a volunteer basis.

12. Upon information and belief, Karen M. Sandler and Bradley M. Kuhn, have continuously served as Registrant's officers since leaving the employ of Petitioner.

13. Bradley M. Kuhn was employed by Petitioner from March 2005 to September 30, 2010.

14. Bradley M. Kuhn was appointed as the full-time executive director of Registrant on October 4, 2010.

15. By May 2, 2011 Petitioner and Registrant no longer had any board members in common

between them.

16. From approximately July of 2011 onwards, Registrant was operated completely independently from Petitioner, the two organizations having no board members, officers, or employees in common.

**GROUND FOR CANCELLATION – LIKELIHOOD OF CONFUSION**

17. Petitioner hereby incorporates by reference paragraphs 1 through 16 as if fully stated here.

18. Registrant's SOFTWARE FREEDOM CONSERVANCY Mark is confusingly similar to Petitioner's SOFTWARE FREEDOM LAW CENTER Mark. Both marks incorporate the identical element "Software Freedom" at the beginning of the mark, followed by a descriptive noun or compound noun. The appearance and sound of the two marks are initially identical when read or pronounced. These first two identical words thus comprise the dominant portion of each of the marks both in terms of their salience as well as in the number of letters.

19. There are no other registered trademarks on the primary register of the USPTO that incorporate the element "Software Freedom" other than those of Petitioner and Registrant.

20. The services provided by Petitioner and Registrant are related in significant ways: both entities offer support services for FOSS projects and developers.

21. Registrant's services with which it uses the SOFTWARE FREEDOM CONSERVANCY Mark are offered to the same class of consumers as Petitioner's services with which it uses the SOFTWARE FREEDOM LAW CENTER Mark, namely FOSS projects and developers.

22. There have been several instances of actual confusion between Petitioner's and Registrant's marks, including on websites, message boards, in phone calls to Petitioner, and in donation queries, and such confusion is likely to continue to occur.

23. Actual confusion has been acknowledged by Karen M. Sandler and Bradley M. Kuhn during public podcasts recorded while employed by Petitioner.

24. Registrant's registration should be canceled because it consists of or comprises a mark which so resembles Petitioner's previously used and registered SOFTWARE FREEDOM LAW CENTER Mark

as to be likely, when used in connection with Registrant's goods and services, to cause confusion, mistake, or deception within the meaning of 15 U.S.C § 1052(d), and to cause damage to Petitioner thereby.

25. Karen M. Sandler, an attorney, was employed by Petitioner at the time Petitioner registered the SOFTWARE FREEDOM LAW CENTER Mark, and was the correspondent on behalf of Petitioner in its application and filings for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO.

26. Karen M. Sandler declared in Petitioner's application for the SOFTWARE FREEDOM LAW CENTER trademark that first date of Petitioner's use of the mark was "at least as early as 02/09/2005".

27. Karen M. Sandler signed a declaration stating in part that she was "properly authorized to execute this application on behalf of the applicant" and "that all statements made on information and belief are believed to be true" when filing Petitioner's application for the SOFTWARE FREEDOM LAW CENTER Mark on June 17, 2010.

28. On November 29, 2011 Registrant filed a Trademark Application (the "Application") for the SOFTWARE FREEDOM CONSERVANCY Mark with the USPTO under 15 U.S.C. Section 1051(a) which included a sworn declaration signed under penalty of perjury by Registrant's general counsel.

29. On April 10, 2012 Registrant filed a Response to Office Action (the "Response") in relation to the Application with the U.S. Trademark Office which included a sworn declaration signed under penalty of perjury by Registrant's general counsel.

30. The Secretary of Registrant's Board of Directors at the time Registration filed the Application and Response was Karen M. Sandler.

31. The President and Chairperson of Registrant's Board of Directors, as well as the Executive Director of Registrant at the time Registrant filed the Application and Response was Bradley M. Kuhn.

32. Registrant swore in both the Application and Response that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or



EXHIBIT 1

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Mark: SOFTWARE FREEDOM LAW CENTER

Software Freedom Law Center

US Serial Number: 85065598

Application Filing Date: Jun. 17, 2010

US Registration Number: 3913979

Registration Date: Feb. 01, 2011

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Apr. 02, 2016

Publication Date: Nov. 16, 2010

## Mark Information

Mark Literal Elements: SOFTWARE FREEDOM LAW CENTER

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "SOFTWARE" AND "LAW CENTER"

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*.\* identify additional (new) wording in the goods/services.

For: Legal services

International Class(es): 045 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 09, 2005

Use in Commerce: Feb. 09, 2005

## Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

## Current Owner(s) Information

Owner Name: Software Freedom Law Center

Owner Address: FL 17  
1995 Broadway

New York, NEW YORK 10023  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country: NEW YORK  
Where Organized:

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: MISHI CHOUDHARY

Attorney Primary Email Address: [MISHI@SOFTWAREFREEDOM.ORG](mailto:MISHI@SOFTWAREFREEDOM.ORG)

Attorney Email Authorized: Yes

### Correspondent

Correspondent Name/Address: MISHI CHOUDHARY  
1995 BROADWAY FLOOR 17  
NEW YORK, NEW YORK 10023  
UNITED STATES

Phone: 2124611912

Correspondent e-mail: [MISHI@SOFTWAREFREEDOM.ORG](mailto:MISHI@SOFTWAREFREEDOM.ORG) [MISHI@SOFTWAREFREEDOM.ORG](mailto:MISHI@SOFTWAREFREEDOM.ORG)

Correspondent e-mail Authorized: Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Apr. 02, 2016	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Apr. 02, 2016	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70132
Apr. 02, 2016	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70132
Feb. 03, 2016	TEAS SECTION 8 & 15 RECEIVED	
Feb. 01, 2016	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Feb. 01, 2011	REGISTERED-PRINCIPAL REGISTER	
Nov. 16, 2010	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 16, 2010	PUBLISHED FOR OPPOSITION	
Oct. 13, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Oct. 13, 2010	ASSIGNED TO LIE	68171
Sep. 29, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 29, 2010	EXAMINER'S AMENDMENT ENTERED	88888
Sep. 29, 2010	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Sep. 29, 2010	EXAMINERS AMENDMENT E-MAILED	6328
Sep. 29, 2010	EXAMINERS AMENDMENT -WRITTEN	82104
Sep. 24, 2010	ASSIGNED TO EXAMINER	82104
Jun. 21, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 21, 2010	NEW APPLICATION ENTERED IN TRAM	

## Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

## TM Staff and Location Information

### TM Staff Information - None

#### File Location

Current Location: TMEG LAW OFFICE 103

Date in Location: Apr. 02, 2016